

REMARKS

Upon entry of the present amendment claims 1-15, 17-23, and 27 are pending in the application. Claims 1 and 18 have been amended, claim 16 canceled, and new claim 27 added.

1. Amendments to the Claims

Claim 1 has been amended to include the limitations of claim 16.

Claim 18 has been amended to correct a typographical error.

The amendment to claim 1 and new claim 27 find support in the examples, particularly in Example 1 wherein the preparation of the rheological aid indicates that the organobismuth catalyst is not removed from the rheological aid after the formation of the urea derivative.

No new matter has been introduced by these amendments.

2. Rejection of claims 1-23 under nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 7,019,042 to Rockrath et al., hereafter "Rockrath", in view of U.S. Patent No. 5,064,871 to Sciangola, hereafter "Sciangola".

In making the rejection the Examiner has asserted that it would have been obvious to use the catalyst of Sciangola in the reactions of Rockrath to obtain the rheological aid of the pending claims. Applicants respectfully disagree.

Rockrath teaches a process for preparing a thixotropic agent comprising urea crystals by reacting at least one primary and/or secondary amine and/or water with at least one polyisocyanate in a liquid organic medium consisting of or comprising at least one compound containing at least one functional group having at least one bond which can be activated with actinic radiation (Rockrath, abstract.)

Sciangola teaches a composition comprising an isocyanate-reactive compound and a catalyst comprising a bismuth carboxylate and a zirconium carboxylate, wherein the catalyst is present in an amount sufficient to catalyze a reaction with the isocyanate-reactive compound and a polyisocyanate (Sciangola, abstract.) Sciangola states that "the use of a zirconium carboxylate in conjunction with a bismuth carboxylate provides a

catalyst for the cure of a composition comprising a polyisocyanate and an isocyanate-reactive compound" (Sciangola, col.1, lines 57-61).

Firstly, Applicants assert that the language of the pending claims does not allow for the use of the catalyst described by Sciangola.

It is well understood that the claims must be interpreted in light of the specification. In this case, Applicants' Specification makes it clear that the term 'organobismuth catalyst' relates to organobismuth compounds only – not to combinations of organobismuth compounds and zirconium carboxylate compounds.

In contrast, Sciangola does not teach a catalyst consisting of an organobismuth compound only. Rather, Sciangola also requires the presence of a zirconium carboxylate.

Accordingly, Applicants respectfully assert that the combination of Rockrath and Sciangola does not teach the instantly claimed rheological aid.

Secondly, Applicants assert that Sciangola and Rockrath cannot be combined.

Sciangola discloses a catalyst that results in the cure of the composition. Rockrath is directed to a thixotropic agent. If the catalyst of Sciangola were used in the compositions of Rockrath the intent of Rockrath would be destroyed as it difficult to imagine how a fully cured composition could be used as a thixotropic agent. The courts have held that "[i]f the proposed modification would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon* 733 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The courts have also held that '[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.'" *In re Ratti* 270 F. 2d 810, 123 USPQ 349 (CCPA 1959).

For at least these reasons, Applicants assert that the inventions of independent claims 1 and 27 as well as those of the pending dependent claims are nonobvious in view of Rockrath and Sciangola.

3. **Rejection of claims 1-22 under nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of Rockrath et al.**

Rockrath teaches that the thixotropic agent is preparable by reacting at least one primary and/or secondary amine and/or water with at least one polyisocyanate in an organic medium (Rockrath, column 4, lines 54-57.) Rockrath teaches that the thixotropic agent of the invention comprises the urea crystals in an amount, based on the thixotropic agent, of from 0.1 to 10, more preferably from 0.2 to 9, with particular preference from 0.3 to 8, with very particular preference from 0.4 to 7, and in particular from 0.5 to 6% by weight (Rockrath, column 4, lines 47-53, examples, claim 11.)

The liquid rheological aid of independent claims 1 and 27 is not obvious in view of Rockrath. In particular, Rockrath fails to disclose all of the required limitations of the claimed inventions.

First, the urea derivative as required by amended claim 1 is present in the rheological aid in an amount of more than 10% by weight. Rockrath does not teach or suggest this limitation. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Second, the rheological aid of amended claim 1 must comprise a bismuth compound. Rockrath does not teach or suggest this limitation.

Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). This standard is not met by Rockrath. Accordingly, Applicants respectfully submit that claims 1-22 are not obvious in view of Rockrath because Rockrath does not teach each and every element of independent claim 1. Withdrawal of the rejection is respectfully requested.

4. **Rejection of claims 1-22 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over DE10042152 as translated by U.S. Patent No. 7,019,042 to Röckrath et al., hereafter "Rockrath".**

Regarding the rejection under 35 U.S.C. §102(b)

Claims 1-22 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Rockrath. Applicants respectfully traverse this rejection.

Applicants respectfully assert that the pending claims are not anticipated by Rockrath because Rockrath does not teach each and every element of independent claim 1. To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

Rockrath teaches that the thixotropic agent of the invention comprises the urea crystals in an amount, based on the thixotropic agent, of from 0.1 to 10, more preferably from 0.2 to 9, with particular preference from 0.3 to 8, with very particular preference from 0.4 to 7, and in particular from 0.5 to 6% by weight (Rockrath, column 4, lines 47-53, examples, claim 11.)

Applicants' rheological aid of amended claim 1 requires the urea derivative be present in an amount of more than 10% by weight. Rockrath does not teach or suggest this limitation.

In addition, the rheological aid of amended claim 1 must also comprise a bismuth compound. Rockrath does not teach or suggest this limitation.

Thus, Applicants respectfully submit that claims 1-22 are not anticipated by Rockrath because Rockrath does not teach each and every element of independent claim 1, in particular, the amount of urea derivative in the rheological aid. Withdrawal of the rejection is respectfully requested.

Regarding the rejection under 35 U.S.C. §103(a)

Claims 1-22 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over Rockrath. Applicants respectfully traverse this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

As discussed above, Rockrath does not disclose all the elements of amended claim 1. Thus, Applicants respectfully assert that the present claims 1-22 are not obvious over Rockrath. Withdrawal of the rejection is respectfully requested.

5. Rejection of claims 1-23 under 35 U.S.C. §103(a) as being unpatentable over DE10042152 as translated by U.S. Patent No. 7,019,042 to Rockrath et al., hereafter "Rockrath" in view of U.S. Patent No. 5,064,871 to Sciangola, hereafter "Sciangola".

Claims 1-23 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over Rockrath in view of Sciangola. Applicants respectfully traverse this rejection.

Rockrath and Sciangola have been described above. Applicants respectfully assert that claims 1-23 are nonobvious over Rockrath and Sciangola for at least the reasons presented above in Section 2. Withdrawal of the rejection is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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